

REMARKS

New claims 28-31 have been added. Accordingly, claims 1-14, 22-26, and 28-31 are currently pending in the application, of which claims 1 and 22 are independent. Applicants appreciate the indication that claims 5, 6, and 24 contain allowable subject matter.

Applicants respectfully submit that the above amendments do not add new matter to the application and are fully supported by the specification. Support for the added claims may be found at least in Figures 2, 4, 6, and 8.

Applicants respectfully request reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Claim Objection

In the Office Action, claims 5-6 and 24 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 5, 6, and 24 have not been amended because Applicants respectfully submit that these claims depend from allowable base claims and are allowable at least for this reason.

Accordingly, Applicants respectfully request withdrawal of the objection for claims 5, 6, and 24.

Rejections Under 35 U.S.C. § 103

Claims 1-4, 7, 9-14, 22, 23, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,346,775 issued to Lee, *et al.* ("Lee") in view of U.S. Patent No. 6,331,064 issued to Nishiyama, *et al.* ("Nishiyama"). Applicants respectfully traverse this rejection for at least the following reasons.

To establish an obviousness rejection under 35 U.S.C. § 103(a), four factual inquiries must be examined. The four factual inquiries include (a) determining the scope and contents of the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966).

In view of these four factors, the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007). The Federal Circuit requires that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

Finally, even if the prior art may be combined, there must be a reasonable expectation of success, and the reference or references, when combined, must disclose or suggest every claimed feature. See *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action fails to establish a *prima facie* case of obviousness because it fails to provide a persuasive reason for combining Lee and Nishiyama in the manner claimed. Further, even if combined, the combination fails to disclose or suggest every claimed feature.

I. The Office Action fails to establish a *prima facie* case of obviousness because it fails to provide a persuasive reason for combining Lee and Nishiyama in the manner claimed

The Office Action acknowledges that Lee fails to disclose that the electrode is formed on an outer surface of the first substrate and cites Nishiyama's electrode 35 to cure this deficiency. Applicants disagree. First, as an ordinarily skilled artisan knows, Lee's first electrode 57, which is on the front glass substrate 60, provokes an initial discharge (i.e. address discharge) in the

discharge space 59 together with either the second electrode 51 or third electrode 52 (col. 8, lines 44-45). Placing the second and third electrodes on the outer surface of the rear substrate 50 will prevent this initial discharge from occurring, thus rendering Lee unsatisfactory for its intended purpose. Second, the second and third electrodes 51 and 52 generate a surface discharge in the discharge space 59 to generate light in the space (col. 8, lines 50-51). If these electrodes were placed on an outer surface of Lee's device, they would not generate a surface discharge in the discharge space 59, thus again rendering Lee unsatisfactory for its intended purpose.

Here, Lee's backlight device is completely different than Nishiyama's, and the electrodes can not be moved around with a "stroke of the pen," as the Office Action suggests. Nishiyama's device includes six electrodes, which are made of rings of aluminum foil, around a single discharge tube (col. 5, lines 53-56). In other words, Nishiyama teaches a backlight that includes a cold cathode fluorescent tube surrounded by six rings of aluminum foil. As a skilled artisan knows, a cold cathode fluorescent tube backlight unit is very different from the backlight unit of Lee's Figure 11 and of claim 1, neither of which includes a cold cathode fluorescent tube. A skilled artisan would not make this modification, and the Office Action fails to establish a *prima facie* case of obviousness for at least this reason.

II. The Office Action fails to establish a *prima facie* case of obviousness because even if combined, Lee and Nishiyama fail to disclose or suggest every claimed feature

Claim 1 recites, in relevant part:

a first substrate;
an electrode formed on an outer surface of the first substrate;
a discharge auxiliary layer formed on an inner surface of the first substrate ...
a fluorescent layer formed on the first substrate

According to claim 1, the electrode, discharge auxiliary layer, and fluorescent layer are formed on the first substrate. The Office Action, however, relies on Lee's rear glass substrate 50 and luminescent material layer 58 to teach the first substrate and the fluorescent layer, respectively, of claim 1. Applicants disagree. Lee discloses that luminescent material layer 58 is formed on the front glass substrate 60, not the rear glass substrate 50. In other words, although Lee discloses that luminescent material layer 58 is formed above the rear glass substrate 50, the luminescent material layer 58 is not formed on the rear glass substrate 50. Although claim terms are given their broadest reasonable interpretation, that interpretation must be consistent with the specification, and it "must also be consistent with the interpretation that those skilled in the art would reach" MPEP § 2111. Here, the Office Action interprets "on" to mean "above," which is an unreasonably broad interpretation of "on." Thus, for at least these reasons, Lee fails to disclose or suggest at least this feature of claim 1.

Furthermore, Applicants note that Lee merely discloses a carbon-nanotube 54 and an MgO protection layer 55 formed on a dielectric layer 53 and formed over a rear glass substrate 50 as illustrated in FIG. 11. In contrast, the invention of claim 1 includes a discharge auxiliary layer formed on an inner surface of a first substrate, and the invention of claim 22 includes a discharge auxiliary layer formed on each side of the inner surface of the first substrate.

Claim 22 includes similar features as claim 1. Thus, Lee also fails to disclose or suggest every feature of claim 22 for at least the reasons noted above with regard to claim 1.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1 and 22. Claims 2-4, 7, 9-14, 23, 25, and 26 depend from claim 1 or 22 and are allowable at least for this reason. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 1 and 22, and all the claims that depend therefrom, are allowable.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee in view of Nishiyama in further view of U. S. Patent No. 6,774,548 issued to Fran, *et al.* ("Fran"). Applicants respectfully traverse this rejection for at least the following reasons.

Applicants respectfully submit that claim 1 is allowable over Lee and Nishiyama and Fran fails to cure the deficiencies of Lee and Nishiyama noted above with regard to claim 1. Hence, claim 8 is allowable at least because it depends from an allowable claim 1.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 8.

Added Claims

Added claims 28-31 are directed to additional aspects of the invention, which are not disclosed or suggested in the art of record. These claims are allowable at least because they depend from allowable base claims.

Allowable Subject Matter

Applicants appreciate the indication that claims 5, 6, and 24 contain allowable subject matter. Claims 5, 6, and 24 have not been amended because Applicants respectfully submit that these claims depend from allowable base claims and are allowable at least for this reason.

CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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